



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/802,367

03/09/2001

Michael E. Last

LMTT-03

8322

826

7590

05/23/2006

ALSTON & BIRD LLP  
BANK OF AMERICA PLAZA  
101 SOUTH TRYON STREET, SUITE 4000  
CHARLOTTE, NC 28280-4000

EXAMINER

MOONEYHAM, JANICE A

ART UNIT

PAPER NUMBER

3629

DATE MAILED: 05/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

**MAILED**

MAY 23 2006

**GROUP 3600**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/802,367  
Filing Date: March 09, 2001  
Appellant(s): LAST, MICHAEL E.

---

Jon M. Jurgovan  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed April 20, 2006 appealing from the Office action mailed October 7, 2005.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is essentially correct.

However, the appellant has not provided the appropriate sites for some of the claim limitations. For example, the appellant states that support for the limitation of generating a ***single web page listing multiple tee times available at a plurality of golf courses*** is found on page 8, line 24 through page 9, lines 4. This section discloses that tee time inventory for a plurality of golf courses is displayed on a ***single user interface*** and that the system displays only a few tee times per course per day but displays tee times on a ***single screen***. Appellant has not provided the appropriate site as to where the single web page listing the multiple tee times available at a plurality of

Art Unit: 3629

golf courses is disclosed. Appellant identifies that the support for the limitation, the **hub server transmits the single web page**, is disclosed in Figure 1 and Field of the Invention, page 1, lines 8-11. This section states as follows:

This invention relates generally to making information generally available through web-based information hubs by posting information to such hubs, and, more particularly, to browser-based tee time posting systems for use by golf courses to post available tee times to tee time reservations hubs.

Appellant further states that retrieving the available tee times from the database **for use in generating the single web page** is found in Figures 1-2 and page 6, line 16 through page 8, line 23. The examiner does not find this disclosed in these segments of the disclosure.

#### **(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

#### **(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

#### **(8) Evidence Relied Upon**

www.golfagent.com retrieved from the Internet Archive Wayback

#### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3629

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 61-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over [www.GolfAgent.com](http://www.GolfAgent.com) (hereinafter referred to as GolfAgent) (retrieved from the Internet Archive Wayback Machine of dates 12/6/1998, 4/28/1999 and 5/2/1999)

Regarding Claim 61:

(The subject matter of this rejection is from pages retrieved on 12/6/1998 only)

GolfAgent discloses a method comprising the steps of:

with a hub server (page 1-via the Internet),

receiving a request for a web page from a golfer computer via a communications network, the golfer computer located remotely from the hub server (enter the data range of when you would like to play – page 1);

in response to the request ,

generating a single web page listing multiple tee times available (all available tee times at this club for reservation by golfers (book tee times), the multiple tee times indicated as available for a golf course for a date being a subset of all of the tee times at the golf course for the date (all available tee times (subset) at this club on the dates you require – page 1); and

transmitting the single web page to the golfer computer via the communications network (it is inherent that the web page is presented to the user since GolfAgent enables users to book tee times and the system informs the user that the tee time is now reserved -page 1).

GolfAgent discloses booking tee times at a wide range of golf courses, displaying courses in a certain geographical area and displaying all available tee times at a club on the dates you require (page 1).

GolfAgent does not explicitly disclose that the multiple tee times at a *plurality of golf courses* are generated on a single web page. However, the Examiner takes Official Notice that it is old and well known to display multiple reservations times from a plurality of entities on a single page. For example, in the travel reservation industry, when one is shopping for an airline reservation and/or hotel reservation or a vehicle rental reservation, the user generally enters the dates that the reservations are needed and a webpage is generated and displayed to the user listing multiple airline carriers and/or hotels from different chains and/or vehicles available for rent at various companies that are available on those dates.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the golf reservation method of GolfAgent which is used to book tee times at a wide range of golf courses to incorporate displaying all available tee times at the plurality of wide range of golf courses as a matter of convenience for the user so that the user can view all the courses in that area having available tee times on the dates you require.

Regarding Claim 62:

(pages for this rejection also include pages with dates of 4/28/1999 and 5/2/1999)

GolfAgent discloses a method as further comprising the steps of:

Art Unit: 3629

receiving specific tee times posted by a plurality of golf course users' computers via the communications network, the golf course users' computers located remotely from the hub server and the golfer computer (page 8, Clubs, using course management software, can easily submit and retrieve tee times to the Internet server),

storing the available tee times in a database (a database is inherent since the information must be stored somewhere so as to be available to be retrieved) , and in response to the request,

retrieving the available tee times from the database for use in the generating the single web page (page 8, when tee times are booked on the Internet indicates that the tee times were retrieved from a search request).

Regarding Claim 63:

(pages for this rejection also include pages with dates of 4/28/1999 and 5/2/1999)

GolfAgent discloses a method further comprising the steps of:

receiving a reservation for a selected golf course and tee time from the user computer via the communications network (page 1 – you can search for the club of your choice by name or if you would like to view courses in a certain geographical area);

storing the reservation in the database (bookings are made by simply clicking on the tee time of interest, reservations are all online via the Internet - thus a database is inherent) ; and

transmitting the reservation to the computer of the selected golf course via the

Art Unit: 3629

communications network (page 8 – when tee times are booked on the Internet, the golfer's details appear on the club's system as if the person had telephoned the club and they had taken the booking themselves).

Regarding Claim 64:

(pages for this rejection also include pages with dates of 4/28/1999 and 5/2/1999)

GolfAgent discloses a method wherein the communications network is the Internet (page 1 Golf Tee Time Bookings Via the Internet).

Regarding Claim 65:

(pages for this rejection also include pages with dates of 4/28/1999 and 5/2/1999)

GolfAgent discloses a method wherein the listing of the multiple available tee times are next-day tee times for respective golf courses (page 1 - enter a data range of when you would like to play would include next-day tee times, the system will show you all available tee times, GolfAgent enables Internet users to book tee times at a wide range (multiple) of golf courses).

Regarding Claim 66:

(pages for this rejection also include pages with dates of 4/28/1999 and 5/2/1999)

GolfAgent discloses a method wherein the request designates a specific geographic region and the single web page is generated to list available tee times for only the golf courses in the specific geographic region (page 1 – you can view courses



Art Unit: 3629

in a certain geographical area, page 4 click on the area you would like to play, when ready enter a date range of when you would like to play and the system will show you all available tee times at this club on the dates you require, page 1)

Regarding Claim 67:

(pages for this rejection also include pages with dates of 4/28/1999 and 5/2/1999)

GolfAgent discloses a method wherein the request includes a date on which the golfer desires to play but does not require the golfer to specify the golfer's desired time of play in order to generate a list of available tee times (when ready enter a date range of when you would like to play and the system will show you all available tee times at this club on the dates you require, page 1)

### **(10) Response to Argument**

#### **A. The GolfAgent Website:**

The appellant states that the Office Action relies only upon versions of the Golf Agent website, ***alleged to be available*** at [www.archive.org](http://www.archive.org).

The Examiner retrieved the GolfAgent website from the Internet Archive Wayback Machine as is evidenced by the information at the bottom of each of the pages provided to the appellant showing that the website was retrieved from the Internet archive and the dates the pages were available. Contrary to appellant's assertion that there appears to be no 5/2/1999 version available on the [www.archive.org](http://www.archive.org) website, the appellant is directed to page 9 wherein at the bottom of the page it shows [web.archive.org/web19990502022040/www.golfagent.com](http://web.archive.org/web19990502022040/www.golfagent.com).

Art Unit: 3629

Moreover, the Examiner has attached, as Exhibit 1, pages from [www.golfagent.com](http://www.golfagent.com) retrieved by the Examiner on May 8, 2005 as evidence that the web pages used in the rejection are still available on the Internet Archive Wayback Machine.

As stated in the Office Action mailed on October 7, 2005, the fact that the appellant is unable to access the web pages does not mean that they do not exist. The Examiner retrieved all of the pages from the Internet Archive Wayback Machine and has provided copies for the appellant.

As for appellant's arguments on page 6, that the 4/28/1999 version of the Golf Agent failed to link to any further web page, instead generating the display on page 7, the Examiner notes that the display states the there is a Failed Connection, Your request failed to connect with our servers.

Furthermore, the Examiner only relies on the pages of GolfAgent provided to the appellant, i.e., pages that are available, not pages that are not shown or not available.

Appellant then argues that there is no disclosure in the GolfAgent website of any generation of a single web page listing multiple tee times available at a plurality of golf courses for reservation by golfers in which the multiple tee times listed as available for each golf course for a date is subset of all of the tee times at the golf course for the date.

The Examiner directs the appellant to the rejection wherein the Examiner states that GolfAgent discloses:

generating a single web page listing multiple tee times available (all available tee times at this club for reservation by golfers (book tee times), the multiple tee times

Art Unit: 3629

indicated as available for a golf course for a date being a subset of all of the tee times at the golf course for the date (all available tee times (subset) at this club on the dates you require – page 1); and

transmitting the single web page to the golfer computer via the communications network (it is inherent that the web page is presented to the user since GolfAgent enables users to book tee times and the system informs the user that the tee time is now reserved -page 1).

GolfAgent discloses booking tee times at a wide range of golf courses, displaying courses in a certain geographical area and displaying all available tee times at a club on the dates you require (page 1).

The Examiner then stated that GolfAgent does not explicitly disclose that the multiple tee times at a *plurality of golf courses* are generated on a single web page. However, the Examiner takes Official Notice that it is old and well known to display multiple reservations times from a plurality of entities on a single page. For example, in the travel reservation industry, when one is shopping for an airline reservation and/or hotel reservation or a vehicle rental reservation, the user generally enters the dates that the reservations are needed and a webpage is generated and displayed to the user listing multiple airline carriers and/or hotels from different chains and/or vehicles available for rent at various companies that are available on those dates.

**B. Legal Requirements for Obviousness under 35 U.S.C. Section 103(a)**

Appellant basically sets forth the requirements set forth in MPEP Section 706.02

(j).

**C. Claims 61-67 are Patentable over the Prior Art**

**C1. Patentability of Independent Claim 61:**

First, the Examiner makes note of the fact that the appellant is not contesting the following limitations:

A method comprising the steps of:

with a hub server,

receiving a request for a web page from a golfer computer via a communications network, the golfer computer located remotely for the hub server.

The appellant argues that the Golf Agent website fails to disclose generating a single web page listing multiple tee times available at a plurality of golf courses for reservation by golfers, the multiple tee times indicated as available for each golf course for a date being a subset of all of the tee times at the golf course for the date.

The appellant then states that this feature of the claimed invention *enables a golfer to view a single web page with multiple golf courses and available tee times, not the entire tee sheet for each golf course, from which the golfer can select. The golfer thus is provided with the variety of selections from multiple golf courses and available tee times for those golf courses on a single web page. The golfer thus need not "drill down" into the specific web pages for a golf course, nor need the golfer be redirected to the golf course's website, either of which requires the golfer to use the move forward*

Art Unit: 3629

*and backward buttons of the browser, thus leading to lost time and frustration of the golfer.*

The Examiner asserts that the appellant is defining the invention with this argument in a manner not disclosed in the appellant's original disclosure.

Appellant's discloses in paragraphs [0033-0035] the following:

[0034] In one embodiment of the invention, the system is adapted to accept inputs and updates from various tee time sources, including from tee time software applications serving a single or multiple golf courses. According to this embodiment, the system may combine databases and importing tee time inventory from multiple sources ***so that tee times from such multiple sources may be offered for reservation by the system to prospective golfers.***

[0035] In one advantageous embodiment of the invention, ***tee time inventory for a plurality of golf courses is displayed on a single user interface.*** The intent is not to display the entire tee, but instead a subset of the available tee times in a convenient fashion that does not require the golfer to undertake an elaborate database query to "zero in" on a desired tee time. The system instead displays only a few tee times per course per day but displays tee times ***from several courses on a single screen.*** In one embodiment of the invention, tee time inventory is gathered from multiple sources, such as the LMTT CCI and from multiple data sources connected to electronic teesheets. One advantage of this approach is that it is much more convenient to a prospective golfer to be able to view a subset of availability from several courses than it is to do an elaborate search. According to this embodiment, the system does not use database search queries so that the display for the golfer is simplified, thus improving the utility to the golfer.

Appellant has provided no disclosure stating that the golfer need not "drill down" into the specific web pages for a golf course, nor that the golfer need not be redirected to the golf course's website. At most, the appellant discloses that the golfer is not required to undertake an elaborate database query to "zero in" on a desired time. The Examiner asserts that there is no disclosure stating a golfer need not "drill down" into

Art Unit: 3629

the specific web pages, especially true in light of the following disclosure in the appellant's specification:

[0006] Online tee time "hubs" such as the LMTT hub at www.lmtt.com have emerged to solve the problem of customer traffic generation experienced by standalone golf course tee time web sites. Hubs such as LMTT offer available tee times from multiple courses so that golfers can view, select and reserve tee times **from multiple courses at a single destination web site**. Courses benefit because the customer traffic to hubs such as LMTT is far greater than the traffic that they can attract to their own standalone sites.

[0014] The web server may also be adapted **to serve golfer web pages containing multiple-course tee time information** to prospective golfers so that the golfers may select and reserve tee times from a list of tee times available at golf courses. Each of the course input web pages may include a list of future tee times at the respective golf course, and an input interface to enable a golf course user to select from the list of future tee times which of the future tee times are to be available to prospective golfers for reservation through the tee time reservations hub. According to one embodiment, the course input web pages are secured so that access by the golf course web browsers to the course input web pages may be controlled.

[0019] The apparatus and methods of the present invention enable golf courses to efficiently post their next-day and advance tee times to a tee time reservations hub like LMTT. The web-based posting process requires almost no operator training and avoids the frequent phone calls and/or faxes required to update tee time hubs using conventional last-minute tee time posting systems. According to one aspect of the invention, **the web server also serves golfer web pages containing multiple-course tee time information** to prospective golfers so that the golfers may select and reserve tee times from a list of tee times available at multiple golf courses.

The Examiner asserts that GolfAgent enables, via a hub server (page 6 *LinksNet server*; page 8 *the main Internet server has many features which are designed to attract use by golfers; clubs using course management software can easily submit and retrieve tee times to the Internet server*), generating a single website/screen/user interface listing multiple tee times available at a plurality of golf

Art Unit: 3629

courses for reservation by golfers (page 1 *GolfAgent – Your Internet Link, Golf Tee Time Bookings via the Internet, Reservations are all on-line and extremely simple; Internet users to book tee times at a wide range of golf courses, You can search for a club of your choice by name, or if you would like to view courses in a certain geographical area you can browse the maps to locate a course at which to play*); the multiple tee times indicated as available for a golf course being a subset of all the tee times at the golf course for the date (*page 1 enter a date range of when you would like to play and the system will show you all available tee times (subset) at this club on the date you require*). The Examiner asserts that GolfAgent discloses transmitting a single webpage to the golfer computer via the communications network (*page 1 GolfAgent allows the user to view the club's web pages and enter a date range of when the user would like to play. The system then shows the user the available tee times at the club on the dates required. The user then books the tee time by simply clicking on the tee time of interest at which time the system informs the user that the tee time is now reserved and tell you how you can pay for it. GolfAgent then states that payment can be via telephone or the secure server.* The Examiner asserts that a webpage is transmitted to the user which enables the users to book tee times and then informs the user that the tee times is now received (page 1).

GolfAgent discloses booking tee times at a wide range of golf courses, displaying courses in a certain geographical area and displaying all available tee times at a club on the dates you require (page 1).

Art Unit: 3629

The Examiner, in light of the appellant's arguments in the Response submitted on June 24, 2005, wherein appellant defines the user interface/ single screen as a single web page, changed the rejection. The Examiner stated that GolfAgent does not explicitly disclose that the multiple tee times at a *plurality of golf courses* are generated **on a single web page**, although GolfAgent enables Internet users to book times at a wide range of golf courses on a single website (page 1). Furthermore, the Examiner took Official Notice that it is old and well known to display multiple reservations times from a plurality of entities on a single page. The Examiner gave as an example the travel reservation industry, wherein when one is shopping for an airline reservation and/or hotel reservation or a vehicle rental reservation, the user generally enters the dates that the reservations are needed and a webpage is generated and displayed to the user listing multiple airline carriers and/or hotels from different chains and/or vehicles available for rent at various companies that are available on those dates.

Thus, the Examiner asserts that Claim 61 is not patentable over the Golf Agent website.

## **C2. The Official Notice Issue**

The Examiner takes Official notice that it is old and well known to display multiple reservation times from a plurality of entities on a single page. The Examiner give as an example the travel reservation industry, wherein when one is shopping for an airline reservation and/or hotel reservation or a vehicle reservation, the user generally enters the dates that the reservations are needed and a webpage is generated and displayed



to the user listing multiple airline carriers and/or hotels from different chains and/or vehicles for rent at various companies that are available on those dates.

Appellant argues that it was *error to take Official Notice of the allegation regarding reservation system used in the travel industry*. The Examiner asserts that this is not an error. The issue being addressed is that it is old and well known in the reservation industry to display multiple reservation times from a plurality of entities on a single web page. The Examiner asserts that the travel reservation example is in the appellant's field of endeavor, reservations, and the example is reasonably pertinent to the particular problem to which the appellant is concerned, i.e., displaying multiple reservation times from a plurality of entities on a single page.

The appellant then states that the allegation for which the Official Notice has been taken is not capable of "instant and unquestionable demonstration as being well-known" as evidenced by the fact that the Examiner has failed to produce evidence. The appellant then argues that the Examiner's failure to provide objective evidence when official notice is challenged demonstrates that such facts are not capable of "instant and unquestionable demonstration" as being "well known."

First, while seasonable, this is the first time that the appellant has challenged the Examiner's Official Notice. The appellant is appealing the Office Action dated October 7, 2005, which is a non-final office action. The first time that the Examiner used Official Notice was in the October 7, 2005 Office Action. Thus, the appeal brief is the first time that the appellant has challenged the Official Notice and the Examiner's Answer is the first opportunity for the Examiner to provide the evidence demanded.

Art Unit: 3629

Furthermore, although seasonable, the Examiner respectfully submits that appellant's arguments and comments do not appear to traverse what Examiner regards as knowledge that would have been generally available to one of ordinary skill in the art at the time the invention was made. Even if one were to interpret appellant's arguments and comments as constituting a traverse, appellant's arguments and comments do not appear to constitute an adequate traverse because appellant has not specifically pointed out the supposed errors in the examiner's action, which would include stating ***why the noticed fact is not considered to be common knowledge or well-known in the art.*** 27 CFR 1.104(d)(2), MPEP 707.07(a). An adequate traverse must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying Examiner's notice of what is well known to one of ordinary skill in the art. In re Boon, 439 F.2d 724, 728, 169 USPQ 231, 234 (CCPA1971). . The appellant's only argument is that the Examiner has not provided documentary evidence.

While the Examiner asserts that appellant has not provided an adequate challenge to the Official Notice, the Examiner will, however, provide documentary evidence that it is old and well known in the reservation industry to display multiple reservation times from a plurality of entities on a single page. MPEP 716.01(d) states when an appellant timely submits evidence traversing a rejection, the examiner must reconsider the patentability of the claimed invention. Thus, the Examiner will reconsider the patentability of the claimed invention as set forth below.

The Examiner has attached documentary evidence that displaying multiple reservation times from a plurality of entities on a single page is old and well known in the reservation industry.

See Exhibit 2 attached wherein the Examiner provides the following evidentiary documents:

Tagawa (US Patent Number 5,732,398) discloses a system for booking reservations wherein the user is asked to input the relevant dates and the inventory database is searched displaying only available reservations on the display screen for selection by the user, the reservation system operating via the Internet (col. 5, lines 17-31; col. 6, lines 16-28; col. 9, lines 34-38; col. 4, lines 5-24; Figure 5a (304) Dates (308) Listing of all lodging choices; Figure 6a (354) Listing of all car companies (356) Dates (360) Available care types with prices; Figure 8a (454) Listing of all airline carriers (456) Dates, (460) Display schedule with prices (only flights with availability); Figure 9a (516) Display options with prices (only available hotels).

Keller et al (US Patent 6,304,850) discloses a booking server which presents the user with a web page to enter information, wherein a request may be for the booking server to search among all carriers and display lowest available fares to the user (Figure 2 (201), wherein the user can select displayed fares (Figure (202). See Figures 1 and 2 and discussion in col. 2, line 53 through col. 3, line 56).

Daughtrey (US 6,801,226) which discloses a graphical user interface implemented as a web page that displays summarized travel options (Figures 2-7). Daughtrey further discloses that, in Figure 3, a web page 70 depicts results from the

Art Unit: 3629

server process 16, the web page 70 includes a table 72 that summarizes travel options by flight times and travel information by airports (col. 3, lines 4-11).

Jones et al. (US 2002/0156661) discloses displaying available reservation information, available flights and their times and prices, on a display screen (Figure 2b and [0045]).

See also, Vance et al. (US 6,442,526) Figures 14F-14G, 14I-14J, 14L-14M.

MPEP 2144.3 states:

Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. While "official notice" may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute" (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)). In *Ahlert*, the court held that the Board properly took judicial notice that "it is old to adjust intensity of a flame in accordance with the heat requirement."

The appellant's application was not under final rejection when the Official Notice was taken. The facts asserted to be well-known or to be common knowledge in the art are, in fact, capable of instant and unquestionable demonstration as being well-known, as is evidenced by the Exhibit 2. Thus, the Official Notice was not in error. The references in Exhibit 2 are submitted solely for the purpose of showing that it is old and well known in the reservation industry to display multiple available reservations for multiple entities on a single page.

### **C3. Additional Errors:**

The appellant argues that, assuming the reservation system the Examiner alleges existed, the appellant argues that there is no motivation in the prior art that would have lead a person of ordinary skill in the art to combine such reservation system with GolfAgent.

In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation is found in the knowledge generally available to one of ordinary skill in the art.

The appellant argues that there is no teaching, suggestion or motivation that would have led a person of ordinary skill in the art to combine a reservation system alleged to have existed in the travel industry with GolfAgent.

The Examiner asserts that this argument is without merit. The issue being addressed is that it is old and well known in the reservation industry to display multiple reservation times from a plurality of entities on a single web page. The Examiner asserts that the travel reservation example is in the appellant's field of endeavor, reservations, and the example is reasonably pertinent to the particular problem to which

Art Unit: 3629

the appellant is concerned, i.e., displaying multiple reservation times from a plurality of entities on a single page.

Secondly, travel industry and tee time reservations are often found together. See attached Exhibit 3. Tagawa (US 5,732,398), cited above, discloses options which include purchasing airport transfers, restaurant reservations, and golf reservations (tee times) (col. 18, lines 13-24). Mankes (US 6, 477, 503) cited to the appellant in earlier Office Actions, discloses tee times, diner reservations, movie rentals, salon appointments (Figure 8). *Tee Up Your Next Golf Vacation with Expedia.com* discloses that Expedia, Inc. has unveiled a new special interest travel section. Teaming up with TheGolfer.com, the leading tee time booking service, Expedia.com travel service has introduced Golf Travel, a section that offers travelers an easy-to-use resource to research and book golf vacations and tee times.

In response to appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the appellant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

As for appellant's argument that a person of ordinary skill in the art would have not reason or basis upon which to expect success in making the combination, the

Art Unit: 3629

Examiner respectfully disagrees. The appellant's field of endeavor is reservations. The Examiner has provided documentary evidence that it is old and well known in the reservation field to display a multiple reservations from a plurality of entities on a single page. Furthermore, The appellant has presented no evidence showing that there is no reasonable expectation of success.

MPEP 2143.02 states:

Reasonable Expectation of Success Is Required

OBVIOUSNESS REQUIRES ONLY A REASONABLE EXPECTATION OF SUCCESS

The prior art can be modified or combined to reject claims as prima facie obvious as long as there is a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986)

AT LEAST SOME DEGREE OF PREDICTABILITY IS REQUIRED;  
APPELLANTS MAY PRESENT EVIDENCE SHOWING THERE WAS NO  
REASONABLE EXPECTATION OF SUCCESS

Obviousness does not require absolute predictability, however, at least some degree of predictability is required. ***Evidence showing there was no reasonable expectation of success may support a conclusion of nonobviousness.*** In re Rinehart, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976).

#### C4. Objective Evidence of Nonobviousness

This objective evidence of nonobviousness is being considered by the Examiner for the first time in the Examiner's Answer. Appellant originally submitted the exhibits on February 17, 2005, wherein appellant submitted both 131 and 132 affidavits/declarations, along with a RCE, in response to the Final Office Action mailed on November 17, 2004. The prior art cited in that Office Action was a website,

Art Unit: 3629

www.linkstime.com, (referred to as Linkstime), and Linkstime in view of Mankes (US 6,477,503). The next Office Action, mailed on March 25, 2005, was a non-final action. In this action, the Examiner presented new grounds of rejection using GolfAgent as the prior art. The appellant responded to the Examiner's Office Action on June 24, 2005, wherein appellant did not present the objective evidence of nonobviousness as to the new grounds of rejection. Thus, this objective evidence is being considered by the Examiner for the first time in this Examiner's Answer.

Upon careful consideration and review, the Examiner finds that the declarations under 37 CFR 1.132 filed February 17, 2005 are insufficient to overcome the rejection of claims 61-67 based upon GolfAgent as set forth in the last Office action. See detailed discussion below.

#### **C4.1. Commercial success of the claimed invention.**

Exhibit 1 Declaration of Michael E. Last

Paragraphs 1-38 are presented as evidence of conception and due diligence. That is not at issue on this appeal.

Paragraphs 39-45: The appellant states that these paragraphs are directed to Mr. Last's testimony regarding the commercial success of the claimed invention. The declarant states in paragraph 41 the "I believe that the key difference between LMTT's system and TeeMaster's as it existed in 1999 is in the claimed method of serving the unique golfer interface which, on a single webpage displays multiple available tee times at a plurality of courses.



Art Unit: 3629

MPEP 716.03 requires the following:

**Commercial Success**

**I. NEXUS BETWEEN CLAIMED INVENTION AND EVIDENCE OF COMMERCIAL SUCCESS REQUIRED**

An appellant who is asserting commercial success to support its contention of nonobviousness bears the burden of proof of establishing a nexus between the claimed invention and evidence of commercial success.

The Federal Circuit has acknowledged that appellant bears the burden of establishing nexus, stating:

In the ex parte process of examining a patent application, however, the PTO lacks the means or resources to gather evidence which supports or refutes the appellant's assertion that the sale constitute commercial success. C.f. Ex parte Remark, 15 USPQ2d 1498, 1503 (Bd. Pat. App. & Int. 1990)(evidentiary routine of shifting burdens in civil proceedings inappropriate in ex parte prosecution proceedings because examiner has no available means for adducing evidence). Consequently, the PTO must rely upon the appellant to provide hard evidence of commercial success.

In re Huang , 100 F.3d 135, 139-40, 40 USPQ2d 1685, 1689 (Fed. Cir. 1996). See also In re GPAC, 57 F.3d 1573, 1580, 35 USPQ2d 1116, 1121 (Fed. Cir. 1995); In re Paulsen, 30 F.3d 1475, 1482, 31 USPQ2d 1671, 1676 (Fed. Cir. 1994) (Evidence of commercial success of articles not covered by the claims subject to the 35 U.S.C. 103 rejection was not probative of nonobviousness). The term "nexus" designates a factually and legally sufficient connection between the evidence of commercial success and the claimed invention so that the evidence is of probative value in the determination of nonobviousness. Demaco Corp. v. F. Von Langsdorff Licensing Ltd., 851 F.2d 1387, 7 USPQ2d 1222 (Fed. Cir. 1988).

Mr. Last has provided no evidence of commercial success, except for his own testimony. Furthermore, Mr. Last has provided no nexus between any evidence of commercial success and the claimed invention, i.e., the single webpage displaying multiple available tee time at a plurality of courses. Mr. Last testifies that usage of the web site has grown. However, he fails to connect the increased usage to the single

Art Unit: 3629

web page. There is no objective evidence comparing usage between a single web page and multiple web pages. Appellant has not provided evidence that the commercial success is due to the single web page displaying multiple tee times at a plurality of courses. The increase in usage that Mr. Last testifies to could very well be the result of growth in Internet usage wherein everyone started to use the Internet as a way to book reservations or due to advertising.

The appellant states in the appeal brief that *Mr. Last's Declaration makes clear, the growth of use of the LMTT system has been staggering in terms of use by golfers and golf courses, and its financial success is manifest, due in large part to the use of the methods of claims 61-67.*

The appellant is directed to MPEP 716.03 (a):

716.03(a) [R-2] Commercial Success Commensurate in Scope With Claimed Invention

#### I. EVIDENCE OF COMMERCIAL SUCCESS MUST BE COMMENSURATE IN SCOPE WITH THE CLAIMS

***Objective evidence of nonobviousness including commercial success must be commensurate in scope with the claims.*** In re Tiffin, 448 F.2d 791, 171 USPQ 294 (CCPA 1971) (evidence showing commercial success of thermoplastic foam "cups" used in vending machines was not commensurate in scope with claims directed to thermoplastic foam "containers" broadly). In order to be commensurate in scope with the claims, the commercial success must be due to claimed features, and not due to unclaimed features. Joy Technologies Inc. v. Manbeck, 751 F. Supp. 225, 229, 17 USPQ2d 1257, 1260 (D.D.C. 1990), aff'd, 959 F.2d 226, 228, 22 USPQ2d 1153, 1156 (Fed. Cir. 1992) (Features responsible for commercial success were recited only in allowed dependent claims, and therefore the evidence of commercial success was not commensurate in scope with the broad claims at issue.).

***An affidavit or declaration attributing commercial success to a product or process "constructed according to the disclosure and claims of [the] patent application" or other equivalent language does not establish a***

**nexus between the claimed invention and the commercial success because there is no evidence that the product or process which has been sold corresponds to the claimed invention, or that whatever commercial success may have occurred is attributable to the product or process defined by the claims.** Ex par Ex parte Standish, 10 USPQ2d 1454, 1458 (Bd. Pat. App. & Inter. 1988).

The appellant has provided no objective evidence of nonobviousness including any evidence or proof of commercial success attributable to the invention defined by the claims. MPEP 716.03(b) states that the commercial success must be derived from the claimed invention.

#### I. COMMERCIAL SUCCESS MUST BE DERIVED FROM THE CLAIMED INVENTION

In considering evidence of commercial success, care should be taken to determine that the commercial success alleged is directly derived from the invention claimed, in a marketplace where the consumer is free to choose on the basis of objective principles, and that such success is not the result of heavy promotion or advertising, shift in advertising, consumption by purchasers normally tied to appellant or assignee, or other business events extraneous to the merits of the claimed invention, etc. In re Mageli, 470 F.2d 1380, 176 USPQ 305 (CCPA 1973) (**conclusory statements or opinions that increased sales were due to the merits of the invention are entitled to little weight**); In re Noznick, 478 F.2d 1260, 178 USPQ 43 (CCPA 1973).

In ex parte proceedings before the Patent and Trademark Office, an appellant must show that the claimed features were responsible for the commercial success of an article if the evidence of nonobviousness is to be accorded substantial weight. See In re Huang, 100 F.3d 135, 140, 40 USPQ2d 1685, 1690 (Fed. Cir. 1996) (**Inventor's opinion as to the purchaser's reason for buying the product is insufficient to demonstrate a nexus between the sales and the claimed invention.**). **Merely showing that there was commercial success of an article which embodied the invention is not sufficient.** Ex parte Remark, 15 USPQ2d 1498, 1502-02 (Bd. Pat. App. & Inter. 1990). Compare Demaco Corp. v. F. Von Langsdorff Licensing Ltd., 851 F.2d 1387, 7 USPQ2d 1222 (Fed. Cir. 1988) (In civil litigation, a patentee does not have to prove that the commercial success is not due to other factors. "A requirement for proof of the negative of all imaginable contributing factors would be unfairly burdensome, and contrary to the ordinary rules of evidence."). See also Pentec, Inc. v. Graphic Controls Corp., 776 F.2d 309, 227 USPQ 766

Art Unit: 3629

(Fed. Cir. 1985) (***commercial success may have been attributable to extensive advertising and position as a market leader before the introduction of the patented product***); In re Fielder, 471 F.2d 690, 176 USPQ 300 (CCPA 1973) (***success of invention could be due to recent changes in related technology or consumer demand***; here success of claimed voting ballot could be due to the contemporary drive toward greater use of automated data processing techniques); EWP Corp. v. Reliance Universal, Inc., 755 F.2d 898, 225 USPQ 20 (Fed. Cir. 1985) (evidence of licensing is a secondary consideration which must be carefully appraised as to its evidentiary value because licensing programs may succeed for reasons unrelated to the unobviousness of the product or process, e.g., license is mutually beneficial or less expensive than defending infringement suits).

Exhibit 3:

Declaration by Joseph Ferguson

In the Remarks/Arguments filed on February 17, 2005 and again in the appeal brief, appellant states that *[i]n paragraphs 2-3 of his Declaration, Mr. Ferguson testifies that he appreciated the value of LMTT system in providing a golfer web interface listing multiple tee times, but less than all of the tee times, for multiple golf courses on a single web page so much so he considered investing in the company.*

The declaration is not objective evidence of commercial success nor does it provide any nexus between any alleged commercial success and the claimed invention.

Exhibit 4:

Declaration of Carl Danbury:

The appellant states that *paragraph 5 of the Declaration indicates that dozens of golfers that play in numerous golfing events each year comment on using the LMTT*

Art Unit: 3629

*website to reserve tee times and appreciate the convenience it provides through the booking interface.*

The Examiner asserts that this testimony does not provide any evidence of commercial success or any nexus between the commercial success and the claimed invention.

Exhibit 5:

Declaration of Brandy Jones:

*Appellant states that Mr. Jones testifies that golfers who reserve tee times at LMTT website to play golf at his golf course routinely comment on how easy the LMTT website is to use due to the simplified golfer interface and that his own experience use of the golf course interface has been easy. This testimony evidences the commercial success of the LMTT website due to the implementation of the claimed method.*

The Examiner asserts that this testimony does not provide any objective evidence of commercial success or any nexus between the commercial success and the claimed invention.

Exhibit 6:

An article published May 2000 in Golf News:

*The appellant states that the article describes the significant growth of golfers and golf course users using the LMTT website and their appreciation of its benefit.*

Art Unit: 3629

The Examiner asserts that these statements do not provide any evidence of commercial success or any nexus between the commercial success and the claimed invention.

Exhibit 7:

An article published in the Atlanta Catalyst magazine:

Appellant states that it explains *some of the benefits of the LMTT website that have led to its commercial success.*

The Examiner asserts that this does not provide any evidence of commercial success or any nexus between the commercial success and the claimed invention.

## 2. Long-Felt Need in the Art:

MPEP 716.04 Long-Felt Need and Failure of Others

I. THE CLAIMED INVENTION MUST SATISFY A LONG-FELT NEED WHICH WAS RECOGNIZED, PERSISTENT, AND NOT SOLVED BY OTHERS

***Establishing long-felt need requires objective evidence that an art recognized problem existed in the art for a long period of time without solution.*** The relevance of long-felt need and ***the failure of others*** to the issue of obviousness depends on several factors. ***First, the need must have been a persistent one that was recognized by those of ordinary skill in the art.*** In re Gershon, 372 F.2d 535, 539, 152 USPQ 602, 605 (CCPA 1967) ("Since the alleged problem in this case was first recognized by appellants, and others apparently have not yet become aware of its existence, it goes without saying that there could not possibly be any evidence of either a long felt need in the . . . art for a solution to a problem of dubious existence or failure of others skilled in the art who unsuccessfully attempted to solve a problem of which they were not aware."); Orthopedic Equipment Co., Inc. v. All Orthopedic Appliances, Inc., 707 F.2d 1376, 217 USPQ 1281 (Fed. Cir. 1983) (Although the claimed invention

Art Unit: 3629

achieved the desirable result of reducing inventories, there was ***no evidence of any prior unsuccessful attempts to do so.***)

Second, the long-felt need must not have been satisfied by another before the invention by appellant. *Newell Companies v. Kenney Mfg. Co.*, 864 F.2d 757, 768, 9 USPQ2d 1417, 1426 (Fed. Cir. 1988) (Although at one time there was a long-felt need for a "do-it-yourself" window shade material which was adjustable without the use of tools, a prior art product fulfilled the need by using a scored plastic material which could be torn. "[O]nce another supplied the key element, there was no long-felt need or, indeed, a problem to be solved".)

Third, the invention must in fact satisfy the long-felt need. *In re Cavanagh*, 436 F.2d 491, 168 USPQ 466 (CCPA 1971).

## II. >< LONG-FELT NEED IS MEASURED FROM THE DATE A PROBLEM IS IDENTIFIED AND EFFORTS ARE MADE TO SOLVE IT

***Long-felt need is analyzed as of the date the problem is identified and articulated, and there is evidence of efforts to solve that problem***, not as of the date of the most pertinent prior art references. *Texas Instruments Inc. v. Int'l Trade Comm'n*, 988 F.2d 1165, 1179, 26 USPQ2d 1018, 1029 (Fed. Cir. 1993).

## III. >< OTHER FACTORS CONTRIBUTING TO THE PRESENCE OF A LONG-FELT NEED MUST BE CONSIDERED

The failure to solve a long-felt need may be due to factors such as lack of interest or lack of appreciation of an invention's potential or marketability rather than want of technical know-how. *Scully Signal Co. v. Electronics Corp. of America*, 570 F.2d 355, 196 USPQ 657 (1st. Cir. 1977). See also *Environmental Designs, Ltd. v. Union Oil Co. of Cal.*, 713 F.2d 693, 698, 218 USPQ 865, 869 (Fed. Cir. 1983) (presence of legislative regulations for controlling sulfur dioxide emissions did not militate against existence of long-felt need to reduce the sulfur content in the air); *In re Tiffin*, 443 F.2d 344, 170 USPQ 88 (CCPA 1971) (fact that affidavit supporting contention of fulfillment of a long-felt need was sworn by a licensee adds to the weight to be accorded the affidavit, as long as there is a bona fide licensing agreement entered into at arm's length).

Exhibit 1: Paragraphs 46-51 of Mr. Last declaration:

The appellant states that these paragraphs make clear there was a long-felt need for the invention ***at the time it was made***. Mr. Last provides testimony ***that golfers recall the difficulties of reserving tee times back in 1999, and what an improvement LMTT's system was over the way in which a majority of tee times were then made***.

The Examiner notes that there is no evidence of how the majority of tee times were being made back in 1999.

The appellant states one golfer, Scott from Detroit, representative of many, indicates that previous websites for reserving tee times were difficult to use and that using the LMTT website is easier than calling around for tee times.

The Examiner asserts that this declaration does not provide objective evidence that an art recognized problem existed in the art for a long period of time without solution. The relevance of long-felt need and the failure of others to the issue of obviousness depends on several factors. First, the need must have been a persistent one that was recognized by those of ordinary skill in the art. The appellant has provided no evidence that the need was a persistent one that was recognized by those of ordinary skill in the art. The appellant's invention is directed to an Internet reservation booking method. The appellant's testimony is that golfers like Scott from Detroit, whom appellant states is representative of many, indicates that previous websites for reserving tee times were difficult to use and that the LMTT website is easier than calling around for tee times. The Examiner asserts that the testimony of a golfer using an Internet



Art Unit: 3629

booking system does not provide objective evidence that an art recognized problem existed. Furthermore, the need must have been a persistent one that was recognized by those of ordinary skill in the art. The Examiner asserts that a golfer is not one of ordinary skill in the art in the field of Internet reservation booking.

Also, long-felt need is analyzed as of the date the problem is identified and articulated, and there must be evidence of efforts to solve that problem. The appellant has not identified the date the problem was identified and articulated. Furthermore, appellant has provided no evidence of efforts to solve the problem or unsuccessful attempts to solve the problem.

Exhibit 3 - Mr. Ferguson's declaration (paragraphs 2-6):

Mr. Ferguson testifies that his research in the mid 2000 when considering making an investment in LMTT indicated that other websites did not have the LMTT system's golfer web interface listing multiple tee times for each of multiple golf courses on a single web page and that he appreciated the value of this golfer web interface over other (sic) that had existed at the time.

As stated above, this declaration does not provide objective evidence that an art recognized problem existed in the art for a long period of time without solution. This testimony provides no evidence that the need was a persistent one that was recognized by those of ordinary skill in the art. The appellant's invention is directed to an Internet reservation booking method. Mr. Ferguson has not been identified as one of ordinary

Art Unit: 3629

skill in the art in Internet reservation booking. The need must have been a persistent one that was recognized by those of ordinary skill in the art.

Long-felt need is analyzed as of the date the problem is identified and articulated, and there must be evidence of efforts to solve that problem. This testimony does not provide evidence to identify the date the problem was identified and articulated. Furthermore, this testimony provides no evidence of efforts to solve the problem or unsuccessful attempts to solve the problem.

Exhibit 4 - Mr. Danbury's declaration, (paragraphs 3-4):

Mr. Danbury testifies that he looked at similar tee time services in early 2000 and could find none that compared with LMTT's booking page and was so intrigued that he invested in LMTT.

Once again, this declaration does not provide objective evidence that an art recognized problem existed in the art for a long period of time without solution. The testimony provides no evidence that the need was a persistent one that was recognized by those of ordinary skill in the art. The appellant's invention is directed to an Internet reservation booking method. Mr. Danbury has not been identified as one of ordinary skill in the art. The need must have been a persistent one that was recognized by those of ordinary skill in the art.

This testimony does not provide evidence to identify the date the problem was identified and articulated not does it provide evidence of efforts to solve the problem or unsuccessful attempts to solve the problem.

**Exhibit 5 - Mr. Jones' declaration (paragraphs 3-4):**

Mr. Jones testifies that in his seven years in golf, LMTT was the first to provide a golfer interface via the Internet listing multiple tee times at each of multiple golf courses.

This testimony provides no objective evidence that an art recognized problem existed in the art for a long period of time without solution. The relevance of long-felt need and the failure of others to the issue of obviousness depends on several factors. The need must have been a persistent one that was recognized by those of ordinary skill in the art. The Examiner asserts that Mr. Jones seven years in golf is not sufficient to identify him as one of ordinary skill in the art in the field of Internet reservation booking. This testimony provides no evidence as to the date the problem was identified and articulated and provides no evidence of efforts to solve the problem.

**Conclusion:** Appellant states that the claimed subject matter solved a problem that was long standing in the art. However, there is no showing that others of ordinary skill in the art were working on the problem and if so, for how long. In addition, there is no evidence that if persons skilled in the art who were presumably working on the problem knew of the teachings of the above cited references, they would still be unable to solve the problem. See MPEP § 716.04.

**3. Acclaim for the Invention by Experts:**

MPEP 716.05 is directed to *skepticism* of experts, not acclaim by experts.

MPEP 716.05:

Art Unit: 3629

***"Expressions of disbelief by experts*** constitute strong evidence of nonobviousness." *Environmental Designs, Ltd. v. Union Oil Co. of Cal.*, 713 F.2d 693, 698, 218 USPQ 865, 869 (Fed. Cir. 1983) (citing *United States v. Adams*, 383 U.S. 39, 52, 148 USPQ 479, 483-484 (1966)) (The patented process converted all the sulphur compounds in a certain effluent gas stream to hydrogen sulfide, and thereafter treated the resulting effluent for removal of hydrogen sulfide. Before learning of the patented process, chemical experts, aware of earlier failed efforts to reduce the sulfur content of effluent gas streams, were of the opinion that reducing sulfur compounds to hydrogen sulfide would not adequately solve the problem.).

***"The skepticism of an expert***, expressed before these inventors proved him wrong, is entitled to fair evidentiary weight, . . . as are the five to six years of research that preceded the claimed invention." *In re Dow Chemical Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988); *Burlington Industries Inc. v. Quigg*, 822 F.2d 1581, 3 USPQ2d 1436 (Fed. Cir. 1987) (testimony that the invention met with initial incredulity and skepticism of experts was sufficient to rebut the prima facie case of obviousness).

The appellant submits the following evidence:

Exhibit 1: Mr. Last Declaration, paragraph 52:

Mr. Last testifies about an email received from a golfer, Mr. Prinz, who explains that after years of frustration, through the LMTT website, he can look at available tee times at multiple courses and expresses gratitude to LMTT for making the website. The appellant then states that Mr. Prinz's years of experience with golf qualify him as an expert in the field.

The Examiner asserts that this testimony provides no evidence of skepticism of an expert or evidence of expressions of disbelief of an expert. It is merely an opinion, not of skepticism, by gratitude and praise, not by an expert in the field of Internet booking of reservations, but by a golfer.

**Exhibit 4: Carl Danbury Declaration, paragraphs 2 and 5:**

Mr. Danbury indicates that he was so impressed with the service and Web site booking module that he decided to profile this service and company for the first issue of Points North magazine. The appellant asserts that given Mr. Danbury's extensive experience with golf, it is fair to say he is an expert in the field.

The Examiner asserts that this testimony is not evidence of skepticism of an expert or evidence of expressions of disbelief of an expert. Furthermore, the Examiner asserts while Mr. Danbury's extensive experience with golf may make him an expert in the field of golf, it does not make him an expert in the appellant's field of endeavour, a Web site booking module.

**Exhibit 5: Declaration of Mr. Jones, paragraphs 5 and 6:**

Mr. Jones testifies that golfers he encounters routinely comment on the ease of use of the LMTT website and that the LMTT interface is easy to use. The appellant then states that Mr. Jones has over seven years of experience in golf.

The Examiner asserts that this testimony is not evidence of skepticism of an expert or evidence of expressions of disbelief of an expert. Furthermore, the Examiner asserts while Mr. Jones' seven years of experience with golf may make him an expert in the field of golf, it does not make him an expert in the appellant's field of endeavour, a Web site booking method.

Art Unit: 3629

#### **C4.4. Failed Attempts of Others:**

MPEP 716.04 Long-Felt Need and Failure of Others

I. THE CLAIMED INVENTION MUST SATISFY A LONG-FELT NEED WHICH WAS RECOGNIZED, PERSISTENT, AND NOT SOLVED BY OTHERS

***Establishing long-felt need requires objective evidence that an art recognized problem existed in the art for a long period of time without solution.*** The relevance of long-felt need and ***the failure of others*** to the issue of obviousness depends on several factors. ***First, the need must have been a persistent one that was recognized by those of ordinary skill in the art.*** In re Gershon, 372 F.2d 535, 539, 152 USPQ 602, 605 (CCPA 1967) ("Since the alleged problem in this case was first recognized by appellants, and others apparently have not yet become aware of its existence, it goes without saying that there could not possibly be any evidence of either a long felt need in the . . . art for a solution to a problem of dubious existence or failure of others skilled in the art who unsuccessfully attempted to solve a problem of which they were not aware."); Orthopedic Equipment Co., Inc. v. All Orthopedic Appliances, Inc., 707 F.2d 1376, 217 USPQ 1281 (Fed. Cir. 1983) (Although the claimed invention achieved the desirable result of reducing inventories, there was ***no evidence of any prior unsuccessful attempts to do so.***).

Appellant submits as evidence of failed attempts of others the following evidence:

Exhibit 1 Declaration of Mr. Last, paragraphs 53-54:

Mr. Last testifies as to the failed attempts of others to derive the claimed methods. Mr. Last testifies that websites that attempt to put entire tee sheet of a golf course on their websites go out of business due to golfer frustration. Mr. Last testifies that ***most*** of the original tee time reservation websites from 1999 have now gone out of business or have been acquired for relatively little and most have abandoned their old approaches to copy the LMTT website.

Mr. Last testifies that the claimed subject matter solved a problem. However, it has not been established that the problem was long standing in the art. Moreover, there

Art Unit: 3629

is no showing that others of ordinary skill in the art were working on the problem and if so, for how long. In addition, there is no evidence that if persons skilled in the art who were presumably working on the problem knew of the teachings of the above cited reference, they would still be unable to solve the problem. See MPEP § 716.04.

Exhibit 5 Mr. Jones Declaration, paragraph 7:

Mr. Jones testifies that in his experience, golf websites that are single golf course websites or that list the entire tee sheet of a golf course or that require a complex search usually fail.

This testimony does not establish that the claimed subject matter solved a problem that was long standing in the art. Moreover, there is no showing that others of ordinary skill in the art were working on the problem and if so, for how long. In addition, there is no evidence that if persons skilled in the art who were presumably working on the problem knew of the teachings of the above cited reference, they would still be unable to solve the problem. See MPEP § 716.04.

Exhibit 8: a listing of tee time reservations websites that ***are believed*** to have gone out of business.

This evidence does not establish that the claimed subject matter solved a problem that was long standing in the art. Moreover, there is no showing that others of ordinary skill in the art were working on the problem and if so, for how long. In addition, there is no evidence that if persons skilled in the art who were presumably working on

Art Unit: 3629

the problem knew of the teachings of the above cited reference, they would still be unable to solve the problem. See MPEP § 716.04.

Exhibit 9: a website in which the golfer must specify the city, number of golfers, etc. The appellant states that one can readily appreciate that to enter all of this data only to find that the tee time is not available for the date specified, requiring re-entry of data, is a source of frustration to golfers.

This evidence does not establish that the claimed subject matter solved a problem that was long standing in the art. Moreover, there is no showing that others of ordinary skill in the art were working on the problem and if so, for how long. In addition, there is no evidence that if persons skilled in the art who were presumably working on the problem knew of the teachings of the above cited reference, they would still be unable to solve the problem. See MPEP § 716.04.

#### C4.5 Copying

MPEP Section 716.06 addresses copying

Another form of secondary evidence which may be presented by appellants during prosecution of an application, but which is more often presented during litigation, is evidence that competitors in the marketplace are copying the invention instead of using the prior art. However, ***more than the mere fact of copying is necessary to make that action significant because copying may be attributable to other factors such as a lack of concern for patent property or contempt for the patentees ability to enforce the patent.*** Cable Electric Products, Inc. v. Genmark, Inc., 770 F.2d 1015, 226 USPQ 881 (Fed. Cir. 1985). Evidence of copying was persuasive of nonobviousness ***when an alleged infringer tried for a substantial length of time to design a product or process similar to the claimed invention, but failed and then copied the claimed invention instead.*** Dow Chem. Co. v. American Cyanamid Co., 837



Art Unit: 3629

F.2d 469, 2 USPQ2d 1350 (Fed. Cir. 1987). Alleged copying is not persuasive of nonobviousness **when the copy is not identical to the claimed product, and the other manufacturer had not expended great effort to develop its own solution**. Pentec, Inc. v. Graphic Controls Corp., 776 F.2d 309, 227 USPQ 766 (Fed. Cir. 1985). See also Vandenberg v. Dairy Equipment Co., 740 F.2d 1560, 1568, 224 USPQ 195, 199 (Fed. Cir. 1984) (evidence of copying not found persuasive of nonobviousness) and Panduit Corp. v. Dennison Manufacturing Co., 774 F.2d 1082, 1098-99, 227 USPQ 337, 348, 349 (Fed. Cir. 1985), vacated on other grounds, 475 U.S. 809, 229 USPQ 478 (1986), on remand, 810 F.2d 1561, 1 USPQ2d 1593 (Fed. Cir. 1987) (**evidence of copying found persuasive of nonobviousness where admitted infringer failed to satisfactorily produce a solution after 10 years of effort and expense**).

The appellant presents the following as evidence of copying:

Exhibit 1: Mr. Last Declaration, paragraphs 55-71:

Mr. Last testifies to the extensive copying of the claimed method, in many cases **with direct evidence** of copying of these methods from the LMTT website by others.

Mr. Last testifies to the **suspicious circumstances** surrounding the **adoption of features similar to the claimed method**. Mr. Last further testifies that all tend toward the inescapable conclusion that the LMTT website and claimed method have been copied by developers of other websites. The appellant then states by copying the claimed feature of the LMTT website, it is evident that the copyists have learned to appreciate the merit of the claimed methods and the commercial success attainable with them.

The appellant has merely provided opinion testimony as to copying by others. Furthermore, the appellant has provided no direct evidence of copying. The appellant has not provided evidence that the alleged copiers expended great efforts to develop their own solutions. Furthermore, evidence of alleged copying is not persuasive of

Art Unit: 3629

unobviousness when the copy is not identical to the claimed invention. Thus, features similar to the claimed invention would not be evidence of copying persuasive of unobviousness.

#### C4.6. Unexpected Results

716.02(b) Burden on Appellant

##### **BURDEN ON APPELLANT TO ESTABLISH RESULTS ARE UNEXPECTED AND SIGNIFICANT**

The evidence relied upon should establish ***“that the differences in results are in fact unexpected and unobvious and of both statistical and practical significance.”*** Ex parte Gelles, 22 USPQ2d 1318, 1319 (Bd. Pat. App. & Inter. 1992) (***Mere conclusions in appellants’ brief*** that the claimed polymer had an unexpectedly increased impact strength “are not entitled to the weight of conclusions accompanying the evidence, either in the specification or in a declaration.”); Ex parte C, 27 USPQ2d 1492 (Bd. Pat. App. & Inter. 1992) (Appellant alleged unexpected results with regard to the claimed soybean plant, however there was no basis for judging the practical significance of data with regard to maturity date, flowering date, flower color, or height of the plant.). See also In re Nolan, 553 F.2d 1261, 1267, 193 USPQ 641, 645 (CCPA 1977) and In re Eli Lilly, 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990) as discussed in MPEP § 716.02(c).

##### **DIRECT AND INDIRECT COMPARATIVE TESTS ARE PROBATIVE OF NONOBVIOUSNESS**

***Evidence of unexpected properties may be in the form of a direct or indirect comparison of the claimed invention with the closest prior art which is commensurate in scope with the claims.*** See In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980) and MPEP § 716.02(d) - § 716.02(e). See In re Blondel, 499 F.2d 1311, 1317, 182 USPQ 294, 298 (CCPA 1974) and In re Fouche, 439 F.2d 1237, 1241-42, 169 USPQ 429, 433 (CCPA 1971) for examples of cases where indirect comparative testing was found sufficient to rebut a prima facie case of obviousness. The patentability of an intermediate may be established by unexpected properties of an end product “when one of ordinary skill in the

Art Unit: 3629

art would reasonably ascribe to a claimed intermediate the contributing cause' for such an unexpectedly superior activity or property." In re Magerlein, 602 F.2d 366, 373, 202 USPQ 473, 479 (CCPA 1979).

***"In order to establish that the claimed intermediate is a contributing cause' of the unexpectedly superior activity or property of an end product, an appellant must identify the cause of the unexpectedly superior activity or property (compared to the prior art) in the end product and establish a nexus for that cause between the intermediate and the end product."*** Id. at 479.

Appellant's evidence of unexpected results are as follows:

Exhibit 1 Mr. Last Declaration, paragraph 72:

Paragraph 72 reads as follows:

I believe it is counterintuitive to most entities that operate tee times reservations websites that providing a far simplified website displaying less than all of the available tee times for each of a plurality of golf courses on a single webpage display is actually far better approach than providing maximum freedom of choice to reserve tee times through complex search queries. Most website owners assumed that it is better to give the golfer maximum freedom of choice, but in practice I believe I was the first to discover that this approach is not the right one, and most cases fatal to the business of the "online tee times" provider.

This testimony appears to be mere opinion evidence or conclusions by appellant.

Appellant has provided no comparison of the claimed invention with the closest prior art which is commensurate in scope with the claims.

#### **D. Dependent Claims 62-67**

Claim 62: Appellant argues that Golf Agent fails to disclose receiving specific tee times posted by a plurality of golf course users' computers via the communications network, the golf course users' computers located remotely from the hub server and the

Art Unit: 3629

golfer computer, storing the available tee times in a database, and in response to the request, retrieving the available tee times from the database for use in generating the single web page.

The appellant argues that assuming that the Golf Agent website discloses hosting of multiple golf courses' on-line reservation systems, there is no disclosure of use of data for available tee times from multiple golf courses to generate a single web page listing of available tee times at the multiple golf courses without listing the entire tee sheets (i.e., a subset of all tee times).

The Examiner asserts the limitation of generating a single web page listing available tee times at the multiple golf courses without listing the golf courses' entire tee sheet has been addressed above in the discussion as to claim 61.

Claim 62 reads as follows:

receiving specific tee times posted by a plurality of golf course users' computers via the communications network, the golf course users' computers located remotely from the hub server and the golfer computer (Golf Agent on page 1 discloses – GolfAgent enables Internet users to book tee times at a wide range of golf courses, page 8 discloses – Clubs (*plural*), using course management software, can easily submit and retrieve tee times to the Internet server),

storing the available tee times in a database (a database is inherent since the information must be stored somewhere so as to be available to be retrieved) , and  
in response to the request,

retrieving the available tee times from the database for use in the generating a

Art Unit: 3629

single web page (page 1 – the system will show you all available tee times at this club on the dates you required; page 8, when tee times are booked on the Internet indicates that the tee times were retrieved from a search request).

Thus, the Examiner asserts that Golf Agent meets the limitations of claim 62.

Claim 65: The appellant argues that claim 65 recites that the listing of multiple available tee times are next day tee times for respective golf courses. The appellant then asserts that the Golf Agent website fails to disclose this feature.

GolfAgent discloses the listing of multiple available tee time, (page 1 – enter a date range of when you would like to play) and that the times can be next-day tee times for respective golf courses (by allowing for entry of the date range of when you would like to play, this would include tee times in the future, including next day tee times), and Golf Agent discloses that the system will show you all available tee times while enabling Internet users to book tee times a wide range (multiple) of golf course (page 1).

Claims 66: Appellant argues that claim 66 recites that the request designates a specific geographic region and the single web page is generated to list available tee times for only the golf courses in this specific region. Appellant once again argues the single web page that has been set forth in claim 61 and addressed above.

GolfAgent discloses a method wherein the request designates a specific geographic region and the single web page is generated to list available tee times for only the golf courses in the specific geographic region (page 1 – you can view courses

Art Unit: 3629

in a certain geographical area, page 4 click on the area you would like to play, when ready enter a date range of when you would like to play and the system will show you all available tee times at this club on the dates you require, page 1)

Claim 67: Appellant states that claim 67 recites that "the request includes a date on which the golfer desires to play but does not require the golfer to specify the golfers desired time of play in order to generate a list of available tee times.

GolfAgent discloses a method wherein the request includes a date on which the golfer desires to play but does not require the golfer to specify the golfer's desired time of play in order to generate a list of available tee times (when ready enter a date range of when you would like to play and the system will show you all available tee times at this club on the dates you require, page 1).

The Examiner notes that appellant has not addressed the limitations in claims 63 and 64.

## **E. Summary of Errors**

### **E.1. Errors in Failing to Establish the Scope and Content of the Prior Art.**

The appellant argues that the Office action has failed to establish the scope and content of the prior art by not showing where the Golf Agent website, Official Notice, or combination of the two provides a method performed by a hub server in which a single web page listing multiple golf courses available at a plurality of golf courses for

Art Unit: 3629

reservation by golfers, the multiple tee times indicated as available for each golf course for a date being a subset of all of the tee times at the golf course for the date.

Once again the appellant argues against the Official Notice. This has been addressed earlier in the Examiner's Answer.

MPEP 2141 states:

Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy. . .

The Examiner asserts that the Examiner has determined the scope and content of the prior art, ascertained the differences between the prior art and the claims at issue, and resolved the level of ordinary skill in the pertinent art.

## **E. 2 The Differences between the Prior Art and the Claims at Issue**

The appellant asserts that since the Examiner has failed to establish the scope and content of the prior art, it would be impossible for the Office Action to properly consider the differences between the prior art and the claims at issue.

First the Examiner asserts that the scope and content of the prior art has been established. MPEP 2141.02 states that ascertaining the differences between the prior

Art Unit: 3629

art and the claims at issue requires interpreting the claim language, and considering both the invention and the prior art references as a whole. The Examiner has interpreted the claim language and considered both the invention and the prior art reference as a whole as is set forth above.

### **E.3. The Level of Ordinary Skill in the Art**

The appellant states that the Office Action does not attempt to establish the level of ordinary skill in the art, nor does the record in general establish it.

The Examiner directs the appellant to MPEP Section 2141.03.

MPEP Section 2141.03 Level of Ordinary Skill in the Art

SPECIFYING A PARTICULAR LEVEL OF SKILL IS NOT NECESSARY WHERE THE PRIOR ART ITSELF REFLECTS AN APPROPRIATE LEVEL  
If the only facts of record pertaining to the level of skill in the art are found within the prior art of record, the court has held that an invention may be held to have been obvious without a specific finding of a particular level of skill where the prior art itself reflects an appropriate level. *Chore-Time Equipment, Inc. v. Cumberland Corp.*, 713 F.2d 774, 218 USPQ 673 (Fed. Cir. 1983). See also *Okajima v. Bourdeau*, 261 F.3d 1350, 1355, 59 USPQ2d 1795, 1797 (Fed. Cir. 2001).

### **E. 4 Objective Evidence of Nonobviousness**

The appellant argues that the record is replete with objective evidence of nonobviousness which has not been considered or given due weight. As stated above, this evidence has not been considered by the Examiner until this appeal brief.

Appellant originally submitted the exhibits on February 17, 2005, wherein appellant submitted both 131 and 132 affidavits/declarations, along with a RCE, in response to the Final Office Action mailed on November 17, 2004. The prior art cited in that Office



Art Unit: 3629

Action was a website, [www.linkstime.com](http://www.linkstime.com), (referred to as Linkstime), and Linkstime in view of Mankes (US 6,477,503). The next Office Action mailed on March 25, 2005, was a non-final action. In this action, the Examiner presented new grounds of rejection using GolfAgent as the prior art. The appellant responded to the Examiner's Office Action on June 24, 2005, wherein appellant did not present the objective evidence of nonobviousness as to the new grounds of rejection. This objective evidence is being considered by the Examiner for the first time in this Examiner's Answer.

MPEP 716.01 states as follows:

Objective Evidence of Nonobviousness

OBJECTIVE EVIDENCE MUST BE CONSIDERED WHEN TIMELY PRESENT

Affidavits or declarations, when timely presented, ***containing evidence of criticality or unexpected results, commercial success, long-felt but unsolved needs, failure of others, skepticism of experts***, etc., must be considered by the examiner in determining the issue of obviousness of claims for patentability under 35 U.S.C. 103.

716.01(b) Nexus Requirement and Evidence of Nonobviousness

TO BE OF PROBATIVE VALUE, ANY SECONDARY EVIDENCE MUST BE RELATED TO THE CLAIMED INVENTION (***NEXUS REQUIRED***)

The weight attached to evidence of secondary considerations by the examiner will depend upon its relevance to the issue of obviousness and the amount and nature of the evidence.

716.01(c) [R-2] Probative Value of Objective Evidence

I. TO BE OF PROBATIVE VALUE, ***ANY OBJECTIVE EVIDENCE SHOULD BE SUPPORTED BY ACTUAL PROOF***

Objective evidence which must be factually supported by an appropriate affidavit or declaration to be of probative value includes evidence of unexpected results, commercial success, solution of a long-felt need,

Art Unit: 3629

inoperability of the prior art, invention before the date of the reference, and allegations that the author(s) of the prior art derived the disclosed subject matter from the appellant. See, for example, *In re De Blauwe*, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984) ("It is well settled that unexpected results must be established by factual evidence." "[A]ppellants have not presented any experimental data showing that prior heat-shrinkable articles split. Due to the absence of tests comparing appellant's heat shrinkable articles with those of the closest prior art, we conclude that ***appellant's assertions of unexpected results constitute mere argument.***"). See also *In re Lindner*, 457 F.2d 506, 508, 173 USPQ 356, 358 (CCPA 1972); *Ex parte George*, 21 USPQ2d 1058 (Bd. Pat. App. & Inter. 1991).

#### OPINION EVIDENCE

Although factual evidence is preferable to opinion testimony, such testimony is entitled to consideration and some weight so long as the opinion is not on the ultimate legal conclusion at issue. While an opinion as to a legal conclusion is not entitled to any weight, the underlying basis for the opinion may be persuasive. *In re Chilowsky*, 306 F.2d 908, 134 USPQ 515 (CCPA 1962) (expert opinion that an application meets the requirements of 35 U.S.C. 112 is not entitled to any weight; however, facts supporting a basis for deciding that the specification complies with 35 U.S.C. 112 are entitled to some weight); *In re Lindell*, 385 F.2d 453, 155 USPQ 521 (CCPA 1967) (Although an affiant's or declarant's opinion on the ultimate legal issue is not evidence in the case, "some weight ought to be given to a persuasively supported statement of one skilled in the art on what was not obvious to him." 385 F.2d at 456, 155 USPQ at 524 (emphasis in original)).

In assessing the probative value of an expert opinion, the examiner must consider the nature of the matter sought to be established, the strength of any opposing evidence, the interest of the expert in the outcome of the case, and the presence or absence of factual support for the expert's opinion. *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986). See also *In re Oelrich*, 579 F.2d 86, 198 USPQ 210 (CCPA 1978) (factually based expert opinions on the level of ordinary skill in the art were sufficient to rebut the prima facie case of obviousness), *Ex parte Gray*, 10 USPQ2d 1922 (Bd. Pat. App. & Inter. 1989) (statement in publication dismissing the "preliminary identification of a human b-NGF-like molecule" in the prior art, even if considered to be an expert opinion, was inadequate to overcome the rejection based on that prior art because there was no factual evidence supporting the statement); *In re*

Art Unit: 3629

Carroll, 601 F.2d 1184, 202 USPQ 571 (CCPA 1979) (expert opinion on what the prior art taught, supported by documentary evidence and formulated prior to the making of the claimed invention, received considerable deference); In re Beattie, 974 F.2d 1309, 24 USPQ2d 1040 (Fed. Cir. 1992) (declarations of seven persons skilled in the art offering opinion evidence praising the merits of the claimed invention were found to have little value because of a lack of factual support); Ex parte George, 21 USPQ2d 1058 (Bd. Pat. App. & Inter. 1991) (conclusory statements that results were "unexpected," unsupported by objective factual evidence, were considered but were not found to be of substantial evidentiary value).

Although an affidavit or declaration which states only conclusions may have some probative value, such an affidavit or declaration may have little weight when considered in light of all the evidence of record in the application. In re Brandstadter, 484 F.2d 1395, 179 USPQ 286 (CCPA 1973).

An affidavit of an appellant as to the advantages of his or her claimed invention, while less persuasive than that of a disinterested person, cannot be disregarded for this reason alone. Ex parte Keyes, 214 USPQ 579 (Bd. App. 1982); In re McKenna, 203 F.2d 717, 97USPQ 348 (CCPA 1953).

#### 716.01(d) [R-2] Weighing Objective Evidence

##### IN MAKING A FINAL DETERMINATION OF PATENTABILITY, EVIDENCE SUPPORTING PATENTABILITY MUST BE WEIGHED AGAINST EVIDENCE SUPPORTING PRIMA FACIE CASE

When an appellant timely submits evidence traversing a rejection, the examiner must reconsider the patentability of the claimed invention. The ultimate determination of patentability must be based on consideration of the entire record, by a preponderance of evidence, with due consideration to the persuasiveness of any arguments and any secondary evidence. In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The submission of objective evidence of patentability does not mandate a conclusion of patentability in and of itself. In re Chupp, 816 F.2d 643, 2 USPQ2d 1437 (Fed. Cir. 1987). Facts established by rebuttal evidence must be evaluated along with the facts on which the conclusion of a prima facie case was reached, not against the conclusion itself. In re Eli Lilly, 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990). In other words, each piece of rebuttal evidence should not be evaluated for its ability to

Art Unit: 3629

knockdown the prima facie case. All of the competent rebuttal evidence taken as a whole should be weighed against the evidence supporting the prima facie case.

The Examiner asserts that the declarations under 37 CFR 1.132 are insufficient to overcome the rejection of claims 61-67 based upon Golf Agent as set forth in the last Office. Appellant's objective evidence is not supported by actual proof. Appellant states that the claimed subject matter solved a problem that was long standing in the art. However, there is no showing that others of ordinary skill in the art were working on the problem and if so, for how long. In addition, there is no evidence that if persons skilled in the art who were presumably working on the problem knew of the teachings of the above cited references, they would still be unable to solve the problem. See MPEP § 716.04. Appellant claims commercial success. However, appellant has not provided any actual proof of the commercial success or any nexus between the commercial success and the claimed invention. In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

#### **E. 5 No Suggestion or Motivation to Modify or Combine the Prior Art**

Appellant argues that no evidence of record which would indicate that a person of ordinary skill in the art would have been motivated by the prior art to combine the GolfAgent website with reservation systems. Appellant claims that travel reservation systems are non-analogous art.

Although these arguments are repetitive, the Examiner will again address them.

Art Unit: 3629

The issue being addressed is that it is old and well known to display multiple reservation times from a plurality of entities on a single page. Travel reservations are in the appellant's field of endeavor, reservations, and travel reservations are reasonably pertinent to the particular problem to which the appellant is concerned, i.e., displaying multiple reservation times from a plurality of entities on a single page.

In response to appellant's argument that there is no suggestion to modify or combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the Examiner asserts that the teaching, suggestion, and motivation are found in the knowledge available to one of ordinary skill in the art.

#### **E.6 No Reasonable Expectation of Success**

Appellant argues that the GolfAgent website incorporates aspects of both the "shot in the dark" and "drill down" approaches which have proven to be disastrous in commercial contexts. Not only is there no reasonable expectation of success if one were to combine the Golf Agent website with Official notice of alleged reservations systems, there is the opposite - a certainty of failure. As the above evidence

Art Unit: 3629

establishes, approaches like that taken in the Golf Agent website have proven fatal to websites that use them time and time again.

MPEP 2143.02 states:

Reasonable Expectation of Success Is Required

**OBVIOUSNESS REQUIRES ONLY A REASONABLE EXPECTATION OF SUCCESS**

The prior art can be modified or combined to reject claims as prima facie obvious as long as there is a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986)

**AT LEAST SOME DEGREE OF PREDICTABILITY IS REQUIRED;  
APPELLANTS MAY PRESENT EVIDENCE SHOWING THERE WAS NO  
REASONABLE EXPECTATION OF SUCCESS**

Obviousness does not require absolute predictability, however, at least some degree of predictability is required. Evidence showing there was no reasonable expectation of success may support a conclusion of nonobviousness. In re Rinehart, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976).

The appellant has failed to provide evidence showing that there is no reasonable expectation of success of the combination of Golf Agent with the Official Notice taken.

**E. 7 The Prior Art References When Combined Must Teach or Suggest All of the Claim Limitations.**

Appellant argues again that the Office Action admits that the GolfAgent website does not disclose a method in which a hub server generates a single web page showing multiple tee times available for reservation at a plurality of golf courses, the multiple tee times indicated as available for each golf course for a date being a subset of all of the

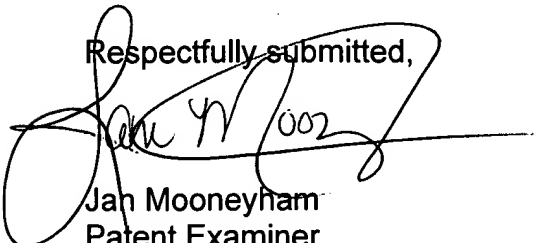
Art Unit: 3629

tee times at the golf course for the date, i.e., GolfAgent does not explicitly disclose that the multiple tee times at a plurality of golf courses are generated on a single web page.

However, the Examiner asserts that GolfAgent, when combined with the Official Notice, does disclose all of the claim limitations.

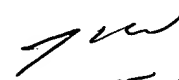
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

  
Jan Mooneyham  
Patent Examiner  
Art Unit 3629

Conferees:

John Weiss, Supervisory Patent Examiner, Art Unit 3629

  
5-15-06

Dean Nguyen, Primary Examiner, Art Unit 3629



### Evidence Appendix

1. Exhibit 1 – pages retrieved from the Internet Archive Wayback Machine
2. Exhibit 2 – evidence relating to the Official Notice.
3. Exhibit 3 - evidence relating to travel reservation and golf tee time bookings.